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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,561	01/18/2002	Winnie C. Durbin	GEMS8081.123	1736

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EXAMINER

SIMITOSKI, MICHAEL J

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/683,561

Applicant(s)

DURBIN ET AL.

Examiner

Michael J. Simitoski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/18/2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The IDS of 2/26/2002 was received and considered.
2. Claims 1-26 are pending.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 17-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a computer data signal, not tangibly embodied.

Claim Rejections - 35 USC § 112

5. Claims 24-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "sufficient time" is indefinite.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 17, 19, 22 & 24 are rejected under 35 U.S.C. 102(e) as being anticipated by **Steinmetz**.

Regarding claim 17, Steinmetz discloses instructions to receive, at a centralized facility/licensing authority (col. 9, lines 31-34), a request to activate an option/configuration (col. 9, lines 31-34) resident in memory of a remote stand-alone device/ATM from a user (col. 16, lines 9-18) remote from the centralized facility/licensing authority (col. 9, lines 54-64), determine whether the user is qualified (has paid) (col. 16, lines 9-18) and if so: grant access to the option resident in the remote stand-alone device (col. 9, lines 62-64) for a limited time period (col. 10, line 61 – col. 11, line 2), generate a software key/authorization key designed to allow access to the option for the limited time period (col. 9, lines 31-44 & col. 10, line 61 – col. 11, line 2) and send the software key to the user (col. 9, lines 11-30).

Regarding claim 19, Steinmetz discloses receiving a user identifier/Customer ID, receiving a system identifier/Terminal ID and receiving an option identifier/Configuration ID (Fig. 5) and to generate the software key to be specific to the user, the system and the option (col. 10, line 57 – col. 11, line 8).

Regarding claim 22, Steinmetz discloses a graphical user interface configured to facilitate user activation of a disabled option resident on a device (Fig. 5), receive a number of user inputs from a user remote from the device (licensing authority receives requests) (col. 9, lines 33-34 & col. 10, lines 57-62), generate an alphanumeric code/authorization key configured to activate the disabled option upon user inputting of the alphanumeric code/authorization key on a data entry

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module/keyboard of the device (col. 5, lines 14-25) and automatically convey the alphanumeric code to the user (col. 11, line 66 – col. 12, line 1).

Regarding claim 24, Steinmetz discloses instructions causing the computer to determine a period of delay, the period of delay representing sufficient time to allow the user to activate the disabled option (col. 10, line 66 – col. 1, line 2).

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Steinmetz**, as applied to claim 17 above, in further view of U.S. Patent Application Publication 2002/0023136 to Silver et al. (**Silver**). Steinmetz lacks instructions to display the software key on a graphical user interface accessible by the user from a computer remote from the centralized facility. However, the examiner takes Official Notice that receiving authorization codes through email is old and well established in the art of software activation as a method of quickly receiving the activation code without the need for paper, as evidenced by U.S. Patent 6,490,684 to Fenstermaker (col. 3, lines 1-4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steinmetz to display the software key on a graphical user interface/email client accessible by the user. One of ordinary skill in the art would have been motivated to perform such a modification to more quickly receive the activation code. This advantage is well known to those skilled in the art. Further, Silver teaches that as opposed to conventional email systems, portable email systems allow the user to access email without a permanent internet connection (§5-8). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steinmetz to use a portable email device according to Silver to receive the email with the authorization code.

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One of ordinary skill in the art would have been motivated to perform such a modification to eliminate the need for a permanent Internet connection, as taught by Silver (§5-8).

9. Claims 20 & 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Steinmetz**, as applied to claim 17 above, in further view of U.S. Patent 6,490,684 to Fenstemaker et al. (**Fenstemaker**). Steinmetz lacks the device being a medical imaging scanner. However, Fenstemaker teaches that it is beneficial for users to try certain features of an ultrasound device without adding any hardware (col. 1, lines 21-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to selectively enable options on a medical imaging device. One of ordinary skill in the art would have been motivated to perform such a modification because there is a need in the art to do so, as taught by Fenstemaker (col. 1, lines 21-32). As modified, Steinmetz lacks the alphanumeric code being encrypted. However, Fenstemaker teaches that encrypting an authorization key reduces the likelihood of unauthorized use of a feature/option (col. 5, lines 1-3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steinmetz to encrypt the authorization key. One of ordinary skill in the art would have been motivated to perform such a modification to reducing reduce the likelihood of unauthorized use of a feature/option, as taught by Fenstemaker (col. 5, lines 1-3).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-5, 7-12, 16-17 & 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,301,666 to **Rive** in view of U.S. Patent U.S. Patent 6,490,684 to Fenstermaker et al. (**Fenstermaker**).

Regarding claims 1, 4, 5, ~~7~~⁷~~8~~, 10, 12, 16, 17, Rive discloses receiving a request and I.D. data from a user of a remotely located stand-alone device/client (col. 16, lines 44-49 & col. 17, lines 32-36) seeking access to a non-enabled option resident on the device (col. 17, lines 37-43), generating an electronic enabler/one-time password configured to enable the non-enabled option, transmitting the electronic enabler to the user and providing instructions to the user to install the electronic enabler/one-time password in the remotely located stand-alone device to activate the option on the remotely located stand-alone device (col. 17, lines 48-55). Rive lacks the device being a medical imaging device. However, Fenstermaker teaches that it is beneficial for users to try certain features of an ultrasound device without adding any hardware (col. 1, lines 21-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to selectively enable options on a medical imaging device. One of ordinary skill in the art would have been motivated to perform such a modification because there is a need in the art to do so, as taught by Fenstermaker (col. 1, lines 21-32).

Regarding claim 2, Rive discloses enabling access for a predetermined period of time/renting (col. 16, lines 37-41 & lines 62-67).

Regarding claim 3, Rive explicitly lacks renting the option for a trial period of thirty days. However, the examiner takes Official Notice that renting an item for thirty days is old and

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well established in the art of renting/leasing as a method of allowing a user to access an option for one month. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rive to rent the option specifically for thirty days. One of ordinary skill in the art would have been motivated to perform such a modification to engage in a monthly subscription. This advantage is well known to those skilled in the art.

Regarding claim 8, Rive discloses generating the electronic enabler upon user satisfaction of a user account/profile (col. 16, lines 43-46).

Regarding claim 9, Rive discloses a centralized facility/supplier (col. 17, lines 38-44) by a user at a workstation remote from the centralized facility, but lacks explicitly a graphical user interface. However, Rive discloses that the request can be sent via email or web (col. 17, lines 33-37), and it is held that both email and web based communication require a graphical user interface.

Regarding claim 11, Rive discloses emailing the alphanumeric code/password (col. 17, lines 49-55).

Regarding claims 20-21, Rive, as modified above, lacks the alphanumeric code being encrypted. However, Fenstermaker teaches that encrypting an authorization key reduces the likelihood of unauthorized use of a feature/option (col. 5, lines 1-3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rive to encrypt the software key. One of ordinary skill in the art would have been motivated to perform such a modification to reducing reduce the likelihood of unauthorized use of a feature/option, as taught by Fenstermaker (col. 5, lines 1-3).

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12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive** and **Fenstermaker**, as applied to claim 12 above, in further view of U.S. Patent Application Publication 2002/0124168 to Mccown et al. (**Mccown**). Rive, as modified, discloses a medical imaging scanner (Pereira, p. 3724, §I), but lacks explicitly disabling the activated option upon expiration of the predetermined and limited time. However, Mccown teaches that one method of licensing components on a computer is to lease a component, wherein when a lease is expired the options on the device are disabled/unstrapped (§43) to inexpensively upgrade a computing environment (§6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rive to disable the activated option upon expiration of the predetermined and limited time/lease expiration. One of ordinary skill in the art would have been motivated to perform such a modification to inexpensively upgrade a computing environment, as taught by Mccown (§6 & §43).

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive** and **Fenstermaker**, as applied to claim 10 above, in further view of U.S. Patent 6,672,505 to Steinmetz et al. (**Steinmetz**). Rive lacks prompting the user to input a user identifier, a system identifier, a stand-alone identifier and a disabled option identifier, generate an electronic license contract and prompt the user to either accept or decline the license contract. However, Steinmetz teaches a user entering a user identifier/Customer ID, a system identifier/Terminal ID (Fig. 5), a stand-alone device identifier/Processor ID (col. 5, lines 26-35) and a disabled option identifier/Configuration ID (Fig. 5) and prompting the user to accept the license terms before enabling the ATM to be configured (col. 13, lines 55-62). Therefore, it would have been obvious

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to one having ordinary skill in the art at the time the invention was made to input a set of data, generate an electronic license contract and prompt the user to either accept or decline the license contract. One of ordinary skill in the art would have been motivated to perform such a modification to compare configuration data to verify the activation key and to enable the ATM according to a license agreement, as taught by Steinmetz (col. 3, lines 23-27, col. 4, lines 29-41, col. 5, lines 26-35, col. 13, lines 55-62 & Fig. 5).

14. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive** and **Fenstermaker**, as applied to claim 17 above, in further view of U.S. Patent Application Publication 2002/0023136 to Silver et al. (**Silver**). Rive discloses displaying the software key on a graphical user interface/email accessible by the user from a computer remote to the centralized facility (col. 17, lines 47-55), but lacks the graphical user interface being remote from the stand-alone device. However, Silver teaches that as opposed to conventional email systems, portable email systems allow the user to access email without a permanent internet connection (§5-8). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a portable email device according to Silver to send and receive the emails in Rive. One of ordinary skill in the art would have been motivated to perform such a modification to eliminate the need for a permanent Internet connection, as taught by Silver (§5-8).

15. Claims 23 & 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Steinmetz**.

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Regarding claim 23, Steinmetz lacks emailing the alphanumeric code to the user via an electronic messaging system and displaying code on a graphical user interface. However, the examiner takes Official Notice that receiving authorization codes through email is old and well established in the art of software activation as a method of quickly receiving the activation code without the need for paper, as evidenced by U.S. Patent 6,490,684 to Fenstemaker (col. 3, lines 1-4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steinmetz to display the software key on a graphical user interface/email client accessible by the user. One of ordinary skill in the art would have been motivated to perform such a modification to more quickly receive the activation code.

Regarding claim 26, Steinmetz discloses instructions causing the computer to determine a period of delay, the period of delay representing sufficient time to allow the user to activate the disabled option (col. 10, line 66 – col. 11, line 2), but lacks the period of delay being 24 hours. However, absent any showing of criticality, it would have been obvious to choose the expiration period to be 24 hours.

16. Claim 6 & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive & Fenstemaker**, as applied to claims 1 & 10 above, in further view of “Something for Nothing – Phone for free, save on books, or build a home page on the house. The Web offers an abundance of free stuff-but watch out for strings” by **Castagna**. Rive, as modified above, lacks emailing an electronic request to the user upon expiration of the period of delay. However, Castagna teaches that demoware is a limited version of a commercial vendor’s application you try for a time before it disables (p. 2, ¶3) and that when downloading the application, an email address is

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collected so the vendor can follow up and try to sell the user the full version (p. 2, ¶5).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made transmit a request for verification of enablement. One of ordinary skill in the art would have been motivated to perform such a modification to follow up with the user to entice a user to purchase the option, as taught by Castagna (p. 2).

17. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Steinmetz**, as applied to claim 24 above, in view of **Castagna** and U.S. Patent Application Publication 2002/0078177 to **Dutta**. Steinmetz, as modified above, lacks emailing an electronic request to the user upon expiration of the period of delay. However, Castagna teaches that demoware is a limited version of a commercial vendor's application you try for a time before it disables (p. 2, ¶3) and that when downloading the application, an email address is collected so the vendor can follow up and try to sell the user the full version (p. 2, ¶5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made transmit a request for verification of enablement. One of ordinary skill in the art would have been motivated to perform such a modification to follow up with the user to entice a user to purchase the option, as taught by Castagna (p. 2). As modified, Steinmetz lacks emailing upon expiration of the period of delay. However, Dutta teaches that to entice a user to buy a subscription, a merchant can contact a user when a trial subscription ends in hopes the user will purchase a subscription (¶7). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to send the email upon the expiration of the period of delay.

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One of ordinary skill in the art would have been motivated to perform such a modification to entice a user to buy a subscription, as taught by Dutta (§7).

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m.. The examiner can also be reached on alternate Fridays from 6:45 a.m. – 3:15 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached at (571) 272-3838.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300
(for formal communications intended for entry)

Or:

(571) 273-3841 (Examiner's fax, for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

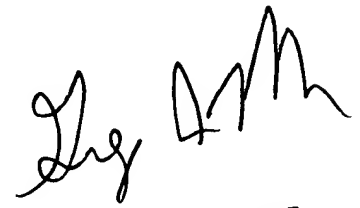
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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MJS

August 4, 2005



GREGORY MORSE
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